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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/714,105	11/17/2000	Walter P. Hempfling	021238-427	4974

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EXAMINER

WALLS, DIONNE A

ART UNIT	PAPER NUMBER
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1731

DATE MAILED: 10/04/2002

71

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/714,105

Applicant(s)

HEMPFLING ET AL.

Examiner

Dionne A. Walls

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) 28-54 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15-27 is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☒ Claim(s) 27 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6-8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
2. Claims 10-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claims 10 and 11 recite the limitation "said drying step" in line 1, and "the darkened tobacco portion" in line 2. There is insufficient antecedent basis for these limitations in the claim.
4. Claim 12 recites the limitation "the primed leaves" in line 3. There is insufficient antecedent basis for this limitation in the claim. Further in this claim and claim 13, it is not clear how "an air-cured tobacco plant" relates to "air-curing tobacco leaves"; i.e. whether the two phrases actually refer to the same thing. Clarification is requested.

Claim Objections

5. Claim 27 is objected to because of the following informality: The claim depends from claim 64 – which is not among the numbered claims. Appropriate correction is requested. For examination purposes, the Examiner assumes that this claim depends from claim 26.

Election/Restrictions

6. Applicant's election of the written restriction in Paper No. 9 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the

restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Note: In the written restriction requirement, the Examiner indicated that the invention embodied in Group I, which Applicant has elected, consists of claims 1-28; however, a typographical error was made. Group I actually encompasses claims 1-27, which means that claim 28 is excluded from this Invention and, therefore, will not be included in the Examination. Claims 1-27 will be examined on the merits.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tso et al (US. Pat. No. 3,845,774).

Tso et al discloses a method for curing tobacco wherein a tobacco product that was subjected to the curing process is contacted with an aqueous alkali/basic solution prior to said curing, and then dried after the curing. Tobacco being subjected to the process are cut leaves (corresponding to the claimed "destemmed leaf") (see col. 2, lines 8-31; example 7, and abstract). While Tso et al may not specifically disclose that the alkaline solution added to the tobacco is a solution of a carbonate or bicarbonate salt, or a sodium bicarbonate, aluminum bicarbonate, etc., it is known, in many arts, that these compounds are basic and capable of raising pH levels. Therefore, it would have

been obvious to one having ordinary skill in the art at the time of the invention to utilize any of these well known salts to add to the tobacco of Tso et al in order to adjust the pH levels of the tobacco medium to be cured.

Regarding claims 2-4, these claims are product-by-process claims and, accordingly, the standards set forth in MPEP 2113 will be followed. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself, i.e. differences in product characteristics, and not on its method of production.

Further, In the event that any differences can be shown for the product of the product-by-process claims, as opposed to the product as taught by the reference, such differences would have been obvious to one of ordinary skill in the art as a routine modification of the product in the absence of a showing of unexpected results; see also *In re Thorpe*, 227 USPQ 964 (CAFC 1985).

When the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternately on either section 102 or 103 is appropriate. As a practical matter, the Patent and Trademark Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith. A lesser burden of proof is required to make out a case of prima facie obviousness for product-by-process claims because of their particular nature than when a product is claimed in the conventional fashion. In re

Brown, 59 CPA 1063, 173 USPQ 685 (1972); In re Fessman, 180 USPQ 324 (CCPA 1974).

Allowable Subject Matter

9. Claims 10-14 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

10. Claims 15-26 are allowed.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

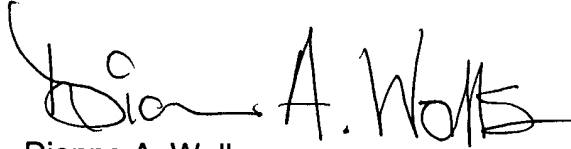
- Poulose et al (US. Pat. No. 4,716,911)
- Livingston (US. Pat. No. 5,125,420).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dionne A. Walls whose telephone number is (703) 305-0933. The examiner can normally be reached on Mon-Fri, 7AM - 4:30PM (Every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P Griffin can be reached on (703) 308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

A handwritten signature in black ink, appearing to read "Dionne A. Walls". The signature is fluid and cursive, with the first name "Dionne" written in a stylized script and the last name "Walls" in a more upright, blocky script.

Dionne A. Walls
September 30, 2002